

Beiersdorf 685-HCL
101769-90
3162-St-sti

REMARKS

Amendment to the Claims

Claims 5 and 6 have been amended as they do not change the scope of the claim. New claims 12-17 have been added. Support for claims can be found throughout the specification, e.g. for claim 12 (page 1, lines 11-12); for claims 13-17 (page 3, lines 34-38). Claims 1-15 are now pending. It is believed that no new matter has been added.

Preliminary Note

The applicants' representative contacted the supervisor of record for this application, Mr. Terrel H. Morris on 26 February 2004 to inquire about and to monitor the status of this application given that the Office Action of record is now the fourth Office Action for this originally filed application (no CPA or RCE's have been filed to date for this application). In addition, Mr. Morris was informed that twice the applicants' have filed Appeal Briefs and twice prosecution on the merits has been reopened without his signature (although in the latest instance, a supervisory patent examiner was consulted and signed the Office Action to reopen prosecution).

If the examiner does not have authority to sign the next communication by himself, the applicants request that Mr. Morris sign the next office action in order to bring this prosecution to finality as he is the supervisory patent examiner of record for this Art Unit.

35 U.S.C. 112, second paragraph rejection

Claim 1 and 4-11 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention for the reasons stated in the previous Office Action. The applicants request reconsideration of this rejection for the following reasons.

It is noted that claim 5 has remained unchanged since the amendment of December 13, 2000 and claims 1 and 6 have been unchanged since the amendment of 27 November 2002 and the Examiner has had several opportunities to raise these rejections but did not feel the need to do so. It is unclear why the cited claims are now deemed to be vague and indefinite. The examiner is reminded that MPEP 2173.02 states:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim

Beiersdorf 685-HCL
101769-90
3162-St-eti

meets the threshold requirements of clarity and precision, ***not whether more suitable language or modes of expression are available***. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. ***Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire***. Examiners are encouraged to suggest claim language to applicants to improve clarity or precision of the language used, ***but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement***. (emphasis added)

None of the rejections cited in paragraphs 3-5 on page 3 of the office action indicate anything more than a preference for alternative language rather than the claims being vague and indefinite. As the applicants' have been trying to be cooperative throughout the prosecution of this application, the applicants' have adopted the examiner's preferences for claims 5 and 6 as this clearly does not change the intended scope of the claim. However, in light of *Festo*, applicants representative cannot in good faith adopt the amendment for claim 1, line 1 when the current language is acceptable on its face.

With regard to the Examiner's interpretation of claim 1, the Examiner is reminded that "[d]uring patent examination, the pending claim must be 'given the broadest reasonable interpretation consistent with the specification'....The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach." (see MPEP 2111 and *In re Cotright*, 165 F.3d 1353, 1359, 49 USPQ 1464, 1468, (Fed. Clr. 1999)). The Examiner's interpretation is unduly limiting as the invention can encompass:

crosslinked epoxy resin		backing material comprising a polyester film
backing material comprising a polyester film	OR	crosslinked epoxy resin
self-adhesive composition		self-adhesive composition

35 U.S.C. 103(a) rejections

Rejections using Kinzer as the primary reference

- (1) Claims 1, 4 and 5 were rejected as being obvious over Kinzer et al. (U.S. Patent 5,667,893) in view of Kolb (U.S. Patent 3,391,053).
- (2) Claims 6, 7 and 11 were rejected as being obvious over Kinzer et al., *id.* in view of Wiest et al. (U.S. Patent 4,322,516).

Beiersdorf 685-HCL
101769-90
3162-St-eti

- (3) Claims 9 and 10 were rejected as being obvious over Kinzer et al., *id.*

Despite the use of a new previously uncited reference, the applicants respectfully submit that this rejection suffers from the same deficiencies as the rejections previously made of record and as such several of the arguments from the Appeal Brief are repeated here in addition to some modifications to account for the new reference and for providing additional clarity.

Summary of Arguments and Positions

- (a) Kinzer does not teach an epoxy component AND an amine component as part of the crosslinked epoxy resin and there is no reason to isolate a teaching from Kolb to combine with Kinzer.
- (b) Kinzer only describes the related art as teaching the use of crosslinked structures. However, there is no evidence that Kinzer's product itself is crosslinked.
- (c) No reasonable expectation of success for modification to Kinzer given the other elements of their invention.
- (d) Kinzer and Wiest would render claim 7 obvious if the obviousness of claim 1 could be established.
- (e) Kinzer does not teach the process of making (claims 9 and 10) the adhesive tape of claim 1.
- (f) Kinzer in view of Wiest does not teach the adhesive tape compositions with the self-adhesive compositions of claims 6 and 11.
- (g) Kneisel does not teach the applicants method of use claim using the adhesive tape of claim 1.

Restatement of the Facts

The essential elements of the appellant's broadest claim (claim 1) is compared with the "Summary of the Invention" of Kinzer is represented in the table below (see next page):

Beiersdorf G85-HCL
101769-90
3162-St-sti

Appellants' claim 1	Kinzer "Summary of the invention" (paraphrased)
An adhesive tape provided on one side with a self-adhesive composition	An article (flexible tape backing or a chip resistant paint)
and comprising a backing material comprising a polyester film coated with a crosslinked epoxy resin , wherein	comprising a substrate coated with a flexible epoxy composition
the crosslinked epoxy resin is prepared using epoxy resins selected from the group consisting of liquid, solvent-free epoxy resins based on bisphenol A, bisphenol F or bisphenol A/F; reactively diluted or plasticized epoxy resins; polyfunctional novolak glycidyl ether resins; aliphatic or cycloaliphatic epoxy resins; and mixtures of said epoxy resins;	wherein the photopolymerizable epoxy composition comprises: (a) a plurality of epoxides including at least one selected from the group consisting of cycloaliphatic epoxides and bisphenol A epoxide,
and wherein said epoxy resins are cured using a curing agent selected from the group consisting of formulated polyethers/polyamines; nonformulated aliphatic polyamines; araliphatic polyamines; cycloaliphatic polyamines; aromatic amine curing agents; modified polyamines; polyamidoamines; polyaminoimidazoline; polyether amines; and formulated adducts or mixtures of said amines.	
	and at least one different aliphatic epoxide,
	(b) from about 0.1 to about 2% of at least one organometallic cationic initiator capable of initiating polymerization at wavelengths of from 200 to about 600 nm, and
	(c) optionally, at least one accelerating agent.

Viewing Kinzer in a light most favorable to the examiner's position, it can be argued that the appellants limitations represented in appellants' claim 4 and 5 are possible additional elements for Kinzer's invention. However, the most glaring difference between the appellants' invention and that of Kinzer is the lack of an explicit recitation for the use of an amine.

Basic Considerations Which Apply to Obviousness Rejections

MPEP 2141 recites in part:

"When applying 35 U.S.C. 103, the following tenets of patent law **must be** adhered to:

- (A) The claimed invention **must be** considered as a whole;
- (B) The references **must be** considered as a whole and **must suggest** the desirability and

Beiersdorf 685-HCL
101769-90
3162-St-ati

- thus the obviousness of making the combination;
- (C) The references **must be** viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined

Hodosh v. Block Drug Co., Inc. 786 F.2d 1136, 1143, n.5, 229 USPQ 187 n.5 (Fed. Cir. 1986)." (emphasis added)

As a Whole Considerations and Impermissible Hindsight Reconstruction

While it is well known that patents are relevant as prior art for all they contain (see MPEP 2123), this still does not absolve the Examiner from considering the appellants' claimed invention and the references cited "as a whole" (see MPEP 2141.02). Moreover, when engaging in this as a whole consideration, the references cannot be viewed with the benefit of hindsight reconstruction. MPEP 2142 states in part:

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination. yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." (emphasis added)

Arguments in favor of non-obviousness

- (a) Kinzer does not teach an epoxy component AND an amine component as part of the crosslinked epoxy resin and there is no reason to isolate a teaching from Kolb to combine with Kinzer

MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). However, the examiner's reliance on Kinzer and Kolb to reject appellants' claims 1, 4 and 5 does not adequately consider the Kinzer reference "as a whole" as is required by the four tenets of patent law for applying 35 U.S.C. 103 as outlined above. The inventions of Kinzer and Kolb considered as a whole can be charted as follows (see next page):

Beicradorf 685-HCL
101769-90
3162-St-sti

Kinzer (Summary of the Invention - paraphrased)	Kolb (abstract)
An article (flexible tape backing or a chip resistant paint)	
comprising a substrate coated with a <i>flexible epoxy composition</i>	A flexible <i>glass-plastic laminate</i>
wherein the <i>photopolymerizable</i> epoxy composition comprises:	of a vapor impermeable glass sheet having a thickness of less than 0.01 inch
(a) a <i>plurality of epoxides</i> including at least one selected from the group consisting of cycloaliphatic epoxides and bisphenol A epoxide,	
and at least one different aliphatic epoxide,	bonded to a plastic layer having a percentage elongation of at least 20 and a thickness of from 0.0005 to 0.02 inch
(b) from about 0.1 to about 2% of at least one organometallic cationic initiator capable of initiating polymerization at wavelengths of from 200 to about 600 nm, and	formed from an epoxy resin or a polyurethane resin.
(c) optionally, at least one accelerating agent,	

Since determination of obviousness based on the prior art does not allow for one of ordinary skill in the art to have the applicants' specification and claims before them to act as a guidepost, it is difficult to see how one of ordinary skill in the art would arrive at the applicants' claims based on the teachings of Kinzer and Kolb described above.

All the Examiner appears to have done by accumulating the references is to find the requisite elements needed to arrive at the applicants invention. However, this is not the standard for establishing a *prima facie* case of obviousness. "[V]irtually all [inventions] are combinations of old elements...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. **Such an approach would be 'an illogical and inappropriate process by which to determine**

Beiersdorf 685-HCT.
101769-90
3162-St-sti

patentability. *Sensotronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).” *In re Rouffat*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457.

Merely collecting the necessary elements from the prior art is insufficient to establish a *prima facie* case of obviousness if consideration as a whole does not lead one to the specific element necessary to complete the invention and/or if there is no teaching, suggestion or motivation to make the appropriate combination.

The examiner had previously stated in his Advisory Action (Paper No. 13) that Kinzer “...may also include hardeners (i.e. amines), etc. (column 6, lines 17-21).” However, the appellants believe this interpretation fails to consider the teachings of Kinzer “as a whole”.

The characterization of hardeners as being equivalent to amines comes from the examiner *not* from the teachings of Kinzer. Furthermore, the recitation of hardeners is within a Markush-like grouping of optional adjuvants (col. 6, lines 17-21 from Kinzer is reproduced below):

Compositions of the invention may also include optional adjuvants such as co-curatives, hardeners, fillers, plasticizers, pigments, antioxidants, surface modifying agents, and the like, in amounts such that they do not interfere with the photopolymerization of the epoxides.

It has long been held that “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” (see *In re Wesslau*, 363 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)).¹

¹ see also *Crown Operations Int'l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1376, 62 USPQ2d 1917, 1922 (Fed. Cir. 2002) - “Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998). There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d at 546, 48 USPQ2d at 1329; *Heidelberger Druckmaschinen AG v. Hentscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) (“When the patented invention is made by combining known components to achieve a new system,

Beiersdorf 685-HCL
101769-90
3162-St-sti

For the present situation, Kinzer does not teach or suggest that one of ordinary skill practice and of the following:

- (1) that the adjuvants are required elements which must be part of Kinzer's invention;
- (2) that hardeners are preferably selected from the Markush group of adjuvants; and
- (3) the hardener must be an amine.

Any argument that it should be permissible to "pick and choose" elements from within the teaching of Kinzer would be counteracted by the sheer volume of possible embodiments should such a standard be allowed. The court of *In re Rice*, 178 USPQ 478 (CCPA 1973) held that, "...the board said, referring to the appellant's ingredients, 'It should be noted that an infinite number of combinations is possible.' Accepting that as an approximation to the truth, we fail to see the obviousness in devising appellant's....[invention] as claimed." *Id.* at 480. The list of optional ingredients which could be added if taking the suggestion from col. 6, lines 17-21 of Kinzer seriously would result in a virtually infinite number of permutations of the invention of Kinzer. Not only is there no direction as to which adjuvant one to select, there is no teaching for selecting a particular species of that adjuvant (i.e. amines) and therefore combination of an amine with the teachings of Kinzer is unobvious.

Kolb does not remedy the differences of Kinzer as there is no reason for one of ordinary skill in the art to look to the glass-laminate arts (Kolb) to address the coating

- (b) Kinzer only describes the related art as teaching the use of crosslinked structures. However, there is no evidence that Kinzer's product itself is crosslinked.

Even if *in arguendo* there was some rationale to "pick and choose" an amine in the teachings of Kinzer, there is nothing within the Kinzer reference which teaches or suggests a crosslinked epoxy resin as in the appellants' invention.

If the examiner had been relying on inherency to establish that Kinzer et al. teaches a crosslinked epoxy resin via the use of an amine, no recitation of facts were acknowledged in

the prior art must provide a suggestion or motivation to make such a combination.").

Boiersdorf 685-HCL
101769-90
3162-St-65

support of such a position.

MPEP 2112 (Requirements of Rejection Based on Inherency; Burden of Proof) states *"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)...To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."* In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), see also *Mentor H/S, Inc. v. Medical Device Alliance, Inc. (Mentor II)*, 244 F.3d 1365, 58 USPQ2d 1321 (Fed. Cir. 2001) and *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

In the present situation, not only is there no factual basis for establishing that Kinzer teaches or is inherently a crosslinked product, there are indications from within Kinzer's own specification that it is not:

- (1) the discussion in Kinzer's "Description of the Related Art" speaks to polymerized, crosslinked structures but also to the problems associated with them which suggests that Kinzer's invention is directed away from the prior art methods. Furthermore, when given the opportunity to describe his own invention, Kinzer distinctly refuses to characterize his invention as a crosslinked polymer;
 - (2) Kinzer appears to teach away from their intended epoxy composition being crosslinked as it is described in their Summary of the Invention that "...the present invention provides an article comprising a substrate coated with a *flexible* epoxy composition" or "*photopolymerizable*" epoxy composition.
- (c) No reasonable expectation of success for modification to Kinzer given the other elements of their invention.

The ultimate determination whether an invention would have been obvious under 35

Beiersdorf 685-HCL
101769-90
3162-St-ati

U.S.C. § 103 is a legal conclusion based on underlying findings of fact (see *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000)).

However, given the additional components which are required by Kinzer et al.'s epoxy composition (i.e. "at least one organometallic cationic initiator") and other optional ingredients thereof ("optionally, at least one accelerating agent" (i.e. peroxides) - see col. 5, line 64 - col. 6, line 3 of Kinzer) and that even in Kinzer's broad recitation of the use of "hardeners" there is included the caveat that such additions are made "in amounts not to interfere with the photopolymerization of the epoxides", there has been no factual basis established for a reasonable expectation of success to add amines to the invention of Kinzer as indicated by the examiner.

MPEP 2143.01 states "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." Kinzer's claimed invention is directed toward "an article comprising a substrate which has coated thereon a **photopolymerizable** epoxy composition". There is no indication that Kinzer also contemplates crosslinked epoxy resins as in the appellants' claimed invention. Kinzer defines "photopolymerization" in col. 3, lines 31-35:

1. The term "photopolymerizable" means that a compound or composition is capable of polymerizing (i.e., being fully cured) when irradiated preferably by ultra-violet emissions in the range of from about 180 nm to about 420 nm.

As such, there is no motivation for one of ordinary skill in the art to select an amine component within the context of Kinzer's invention as this would produce a different epoxy composition than that contemplated by Kinzer.

- (d) **Kinzer in view of Wiest would render claim 7 obvious if the obviousness of claim 1 could be established**

Claim 7 stands or falls with the obviousness of claim 1. As the applicants' believe that claim 1 is unobvious in view of the prior art, a withdrawal of this rejection should also result in a

Beiersdorf 685-HCL
101769-90
3162-St-eti

withdrawal of the rejection of claim 7.

(e) Kinzer does not teach the process of making (claims 9 and 10) the adhesive tape of claim 1

Since claims 9 and 10 are based on the production of the tape of claim 1 and the Examiner has previously indicated that the Kinzer reference alone was insufficient to render the tape of claim 1 to be obvious, the applicants' fail to see how the process claims can be rejected based on Kinzer alone.

Moreover, the Examiner indicated wrote that "a fully cured (or crosslinked) epoxy inherently lacks flow property...it is believed that applying a mixture of starting components of the epoxy resin during their chemical reaction phase (i.e., not fully crosslinked) onto the polyester film substrate is either inherently disclosed, or an obvious nominal coating step to one of ordinary skill in the art."

Applicants' respectfully object to this characterization by the Examiner for two reasons:

First, issues of inherency are questions of fact and MPEP 2112 (Requirements of Rejection Based on Inherency; Burden of Proof) states "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the Inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).....To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citations omitted). Even if it were to be accepted that a fully crosslinked epoxy lacks flow property, it is not necessarily true that Kinzer teaches or desires to apply the components of the epoxy resin directly onto the polyester film.

Second, whether a coating step is nominal or not, there still must be a teaching, suggestion or motivation for including the step. Mere recitation that something is obvious does not make it so. MPEP 2143.01 establishes that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests

Beiersdorf 683-HCL
101769-90
3162-St-sti

the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)". In appropriate circumstances, a single prior art reference can render a claim obvious. see *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.2d 1071, 1074, 37 USPQ2d 1314, 1318 (Fed. Cir 1996). However, there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion. *B.F. Goodrich*, 72 F.3d at 1582, 37 USPQ2d at 1318.

Even if the examiner views the applicants' claimed method of treating or coating as being based on "simple" technology, this still does not preclude providing a motivation to combine the references to arrive at the appellants' claimed invention nor does this lessen the standard for engaging in hindsight reconstruction. It was previously presented in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, (Fed. Cir. 1999) that:

"...Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *Close adherence to this methodology is especially important in the case of less technologically complex inventions*, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.'...Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."

- (f) **Kinzer in view of Wiest does not teach the adhesive tape compositions with the self adhesive compositions of claims 6 and 11.**

Should the rejection based on Kinzer be reversed this rejection would also be reversed. However, further arguments against the combination of Kinzer in view of Wiest are made below in the event that the rejection based on Kinzer is affirmed.

Wiest describes a copolymer which has ranges for the amount of ethylene, vinyl acetate, acrylic acid and methacrylamide which overlaps that of the appellants' claims (presuming that there is equivalence for methacrylamide (Wiest) and acylamide (appellants)). However, what is lacking is any motivation or suggestion to combine the teaching which come from the references

Beiersdorf 685-HCI.
101769-90
3162-St-sti

themselves or from the known state of the art. The examiner's explanation appears to be based on hindsight reconstruction (i.e. presumes that the skilled artisan would have had a copy of the appellants' claims before him when considering the scope of the inventions represented by Kinzer and Wiest). This is not permissible according to MPEP 2142.

Going back in time to the filing date of the applicants claimed invention without the benefit of the appellants claims, one of ordinary skill in the art would already have to have made the remarkable selection of an amine despite the infinite number of additional adjuvants which could be selected and lack of knowledge of the success of using an amine and would then proceed to again pick among the infinite number of copolymers available to select the one described by Wiest. Such a presumption strains credulity and therefore, such a combination would not render the appellants' claimed invention to be obvious.

(g) Rejection based on Kneisel

Claim 8 is rejected as being obvious over Kneisel (U.S. Patent 5,741,383).

The basis for this rejection is unclear as it is well known that "...compounds and their use are but different aspects of, or ways of looking at, the same invention and consequently that invention is capable of being claimed both as new compounds or as a new method or process..." *In re Pleuddemann*, 910 F.2d 823, 827, 15 USPQ2d 1738, 1741 (Fed. Cir. 1990), *see also In re Nancy*, 499 F.2d 1289, 182 USPQ 303 (CCPA 1974), *In re Kuehl*, 475 F.2d 658, 177 USPQ 250 (CCPA 1973). Since the process of using claim is necessarily dependent upon the claimed adhesive tape of claim 1, should the tape be found to be patentable, the process of using would also be patentable.

When considering the Kneisel reference as a whole, there is no indication that the reference teaches or suggests using the adhesive tape described by applicants' claim 1.

Comment about new claims

New claims 12-17 introduce additional limitations to the process of masking claim (claim 12) and the adhesive tapes of the invention (claim 13-17).

Beiersdorf 685-IICL
101769-90
3162-St-sti

MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

In addition, with regard to the claims containing the limitation that the tapes are free of PVC, it is noted that the fourth of the *Graham v. Deere* factors requires evaluating evidence of secondary considerations. The applicants have presented eight (8) examples of their invention which are PVC-free and two comparative examples which contain PVC - see summary of results below:

Ex. #	Tensile strength (N/cm)	Elongation at break	Bond strength on steel (N/cm)	Tearing or splicing on removal?
1	89.8	76.4%	4.4	NO
2	81.5	66.4%	3.8	NO
3	83.2	71.6%	3.4	NO
4	87.8	81.3%	2.8	NO
5	88.5	72.8%	3.1	NO
6	69.2	88.7%	4.0	NO
7	73.3	70.2%	4.3	NO
8	80.6	84.8%	3.5	NO
Avg. 1-8	81.7	76.5%	3.7	NO
Comp. 9	47.2	74.0%	3.8	YES
Comp. 10	71.2	131.1%	3.8	YES

Note that the tapes of the applicants' invention which are PVC-free unexpectedly show increased tensile strength and do not tear or splice upon removal when compared against PVC-containing tapes. For these reasons, while it is believed that all of the claims are allowable on the merits, claims 13-17 has additional support with regard to a showing of unexpected results.

Identification of Allowable Subject Matter

In the interest of compact prosecution, the applicants' representative has repeatedly requested during their telephone conversations that the Examiner identify allowable subject matter to assist in bringing this prosecution to finality.

The applicants again recite for the record that if the examiner believes that there is allowable

Beiersdorf 685-HCL
101769-90
3162-St-sti

subject matter within the dependent claims, it is respectfully requested that such claims be identified as per MPEP 707.07(j) - State When Claims Are Allowable (see also form paragraphs 7.43.01 and 7.43.02).

Public Policy Matters

In order to ensure that the applicants are engaging in equitable conduct, the Examiner is also reminded that this application was filed on 13 December 2000 and such was eligible for Patent Term Adjustment time based on the 3-year rule on 13 December 2003. Failure to achieve finality for the prosecution of this application serves to extend the expiration date of any patent granted from this application which when considering the time allotted for payment of the issue fee and time given for publication of the patent grant is already at about 1 year.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the Issue(s) might be promptly resolved.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (19 pages) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 18 May 2004

By: Agata Glinska
Agata Glinska